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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,714	10/03/2000	Arnaud Vilbert	5725.0622	8388

7590 11/17/2004
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Washington, DC 20005

EXAMINER

MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/582,714	Applicant(s) VILBERT, ARNAUD	
	Examiner Gregory W Mitchell	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 and 32-114 is/are pending in the application.
- 4a) Of the above claim(s) 28-30 and 32-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the remarks filed July 29, 2004. Claims 27-30 and 32-114 are pending. Claims 28-30 and 32-114 have been withdrawn from consideration as being drawn to non-elected subject matter. Claim 27 is examined herein.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2004 has been entered.

Response to Arguments

Applicant's arguments with respect to claim 37 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

Applicant's election with traverse of Group I, drawn to a process for shaping or holding a hairstyle, in the reply filed on July 29, 2004 is acknowledged. The traversal is on the ground(s) that Examiner has not shown sufficient burden of search.

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Furthermore, Applicant alleges that "the search and examination of Group I should include and as such, overlap a search for the subject matter of the other groups."

These is not found persuasive. As pointed out in the Office Action dated April 11, 2003, Groups I-IV fall into different subclassifications and, furthermore, Groups I-IV require different searches. Thus, Groups I-IV are distinct inventions. Additionally, the compounds generically recited as (A) and (B) in the instant claims encompasses and incredible number of chemical compounds and combinations thereof. Thus, a search of all compounds and combinations thereof would place a serious burden on the Examiner. It is also noted that a search for the process of Group I need not encompass or even overlap with the search of a composition of Group IV because the composition need not be utilized for the same purpose to be rendered anticipated.

The requirement is still deemed proper and is therefore made **FINAL**.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatt et al. (USPN 6106808) in view of Ramin et al. (USPN 5683681).

Bhatt et al. discloses the administration of a composition comprising (1) a polyurethane resin (a polycondensate of polyoxyethylene diol, diethylene glycol, dimethylolpropionic acid, and methylene bis-cyclohexyl-4-4'-diisocyanate); Gantrez A425 (a partial butyl ester of vinylmethylether/maleic anhydride copolymer); AMP; ethanol (a cosmetically acceptable medium); and water for setting hair (col. 4, lines 3-18; col. 14, lines 37-61; col. 26, line 50-col. 27, line 29; Table 8). Bhatt et al. teaches that the compositions of the invention provide spray particle sizes of about 20 to 150 microns and that either a pump spray or an aerosol may be used (col. 4, line 20-col. 5, line 15).

Bhatt et al. does not specifically teach a spray wherein the hair composition has an average diameter of less than or equal to 80 microns. Furthermore, Bhatt et al. does not specifically teach that the composition administered therein comprises a film-forming polymer in addition to the polyurethane.

Ramin et al. teaches that butyl esters of vinylmethylether/maleic anhydride copolymers are film-forming polymers (col. 2, lines 31-44).

Accordingly, Bhatt et al. teaches administration of a composition comprising a polycondensate polyurethane; a film-forming polymer; and a cosmetically acceptable medium in a particle size of between 20 and 150 microns from either a pump spray container or an aerosol container for setting (holding) hair.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to administer the composition of Bhatt et al. with a droplet size of less than or equal to 80 microns because such a droplet size overlaps with the droplet size of 20 to 150 microns taught by Bhatt et al. One would have been motivated to administer the composition from Bhatt et al. from either a pump spray or aerosol container in a particle size less than or equal to 80 microns because of an expectation of success in imparting good hair setting retention and achieving a natural feel to the sprayed hair, as taught by Bhatt et al. (col. 4, lines 3-18).

Conclusion

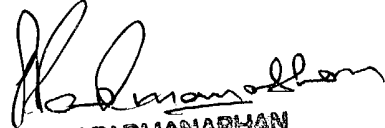
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER